

## **REMARKS**

In response to the above-identified Office Action, Applicant seeks reconsideration of the application in view of the following remarks. In this response, Claims 1, 2, 10, 15, 24 and 26 are amended, no claims are canceled, and no claims are added. Accordingly, Claims 1-32 are pending.

### **I. Claims Rejected Under 35 U.S.C. §112**

The Examiner has rejected Claim 24 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In addition, Claims 2, 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. These matters are believed to be addressed by the claim amendments submitted herewith. It is therefore respectfully submitted that the rejection of Claims 2, 3, 6 and 24 under 35 U.S.C. 112 be withdrawn.

### **II. Claims Rejected Under 35 U.S.C. §102**

Claims 1, 5 and 9 are rejected under 35 U.S.C. § 102(b) as anticipated by both Thompson (U.S. Patent No. 5,022,701) and Marjahn (U.S. Patent No. 4,560,251). Applicant respectfully traverses this rejection.

It is axiomatic that to anticipate a claim, every element of the claim must be disclosed within a single reference. Applicant respectfully submits that neither Thompson nor Marjahn fails to disclose a shade panel to removably attach to a side window assembly by engaging at least an upper peripheral portion of the shade panel between an inner surface of the window and the sealing member as recited in Claim 1.

In view of the foregoing, Applicant respectfully submits that Claim 1 is not anticipated by Thompson or Marjahn and requests withdrawal of the rejection of Claim 1. Dependent Claims 5 and 9 are submitted as not being anticipated by Thompson or Marjahn at least for the reasons given in support of their base Claim 1.

### **III. Claims Rejected Under 35 U.S.C. §103**

Claims 1-11 and 15-25 are rejected under 35 U.S.C. §103(a) as unpatentable over McNelis (U.S. Patent No. D468,245) in view of either Murjan or Chen (U.S. Patent Application Publication No. 2004/0079495). Applicant respectfully traverses this rejection.

With regard to Claim 1, Claim 1 recites a sunshade for use with a side window assembly of a vehicle, the side window assembly including a window frame, a window movable relative to the frame and a sealing member to seal a periphery of the window, wherein the sunshade comprises a shade panel to reduce an amount of light passing through a portion of the window, the shade panel to removably attach to the side window assembly by engaging at least an upper peripheral portion of the shade panel between an inner surface of the window and the sealing member. The Examiner admits that McNelis does not show removable aspect and the ability of the device to be slid between the window and the seal therearound. The Examiner asserts that Murjahn and Chen provide a plastic shade which teach this removably attachable feature.

Applicant respectfully submits that neither Murjahn nor Chen teach a shade panel to removably attach to a side window assembly by engaging at least an upper peripheral portion of the shade panel between an inner surface of the window and the sealing member as recited in amended Claim 1. Murjahn discloses an antiglare shield for exterior mirrors which is designed to minimize headlight glare to a driver from outside rear view mirrors. The antiglare shield 1 taught by Murjahn includes a support section “b” and an unsupported section “a” which are separated by a molding 2, which is configured to meet an upper rim of the vehicle window shaft during insertion of the antiglare shield into the vehicle window shaft. Thus the lower portion of the antiglare shield of Murjahn is clamped between the window and interior wall of the vehicle window shaft. Murjahn fails to teach a shade panel to removably attach to a side window assembly by engaging at least an upper peripheral portion of the shade panel between an inner surface of the window and the sealing member as recited in amended Claim 1.

In rejecting the claims, the Examiner asserts that “Chen et al states that the upper edge of his shade fits within top channel 44 when the window is closed.” However, Chen merely indicates that “the top edge of the sunshade 1 is concealed in a lengthwise groove 44 in a top edge 43 of the doorframe in the closed position.” Applicant notes that the sunshade taught by Chen, as disclosed in paragraph 11, figure 3 of Chen, adheres to the window such that when the window is moved down, the sunshade 1 moves down along with the window into an interior cavity 41 of the doorframe. There is nothing in Chen that teaches or suggests that the sunshade 1 described with respect to Figures 1-3 can removably attach to a side window assembly by engaging at least an upper peripheral portion of the sunshade between the inner surface of the window and the sealing member. Rather, the sunshade 1 taught by Chen attaches to a side

window by adhering to the surface of the window such that the sunshade moves with the window as the window is moved down or up. Therefore, the sunshade taught by Chen does not removably attach to a side window by engaging at least an upper portion of the sunshade between the inner surface of the window and the sealing member as required by Claim 1.

In view of the foregoing, Applicant respectfully submits that independent Claim 1 is patentable over McNelis in view of Murjan or Chen and requests withdrawal of the rejection of Claim 1. Regarding dependent Claims 2-9, Applicant submits that these claims are not obvious in view of the cited references at least for the same reasons given in connection with their base Claim 1.

With regard to Claim 10, Applicant respectfully submits that none of McNelis, Murjan or Chen discloses a shade member that is configured to removably attach to the side window assembly by engaging a first section of the shade member to an upper frame region of the window frame between the inner surface of the side window and the sealing member and a second section of the shade member to a side frame region of the window frame between the inner surface of the side window and the sealing member as recited in Claim 10. As noted above, Murjahn discloses an antiglare shield for exterior mirrors which is designed to minimize headlight glare to a driver from outside rear view mirrors by inserting the lower portion of the antiglare shield between the window and interior wall of the vehicle window shaft. Thus, Murjahn fails to teach a shade member to removably attach to the side window assembly by engaging a first section of the shade member to an upper frame region of the window frame between the inner surface of the side window and the sealing member and a second section of the shade member to a side frame region of the window frame between the inner surface of the side window and the sealing member as recited in Claim 10. Chen also fails to disclose this feature since the sunshade 1 taught by Chen adheres to the surface of the window such that the sunshade moves with the window as the window is moved down or up. Applicant respectfully submits that the sunshade taught by Chen does not removably attach to the side window assembly by engaging a first section of the shade member to an upper frame region of the window frame between the inner surface of the side window and the sealing member and a second section of the shade member to a side frame region of the window frame between the inner surface of the side window and the sealing member as required by Claim 10. In view of the foregoing, Applicant

respectfully submits that independent Claim 10 is patentable over McNelis in view of Murjan or Chen and requests withdrawal of the rejection of Claim 10. Regarding dependent Claim 11, Applicant submits that this claim is not obvious in view of the cited references at least for the same reasons given in connection with their base Claim 10.

With regard to Claim 15, Applicant respectfully submits that none of McNelis, Murjan or Chen discloses removably attaching the structure to a side window of a vehicle by sliding the structure along an inner surface of a side window of a vehicle, and engaging at least an upper peripheral portion of the structure between the inner surface of the side window and a sealing member portion affixed to an upper frame portion of a window frame as recited in Claim 15. As noted above, Murjahn discloses an antiglare shield for exterior mirrors which is designed to minimize headlight glare to a driver from outside rear view mirrors by inserting the lower portion of the antiglare shield between the window and interior wall of the vehicle window shaft. Thus, Murjahn fails to teach engaging at least an upper peripheral portion of the structure between the inner surface of the side window and a sealing member portion affixed to an upper frame portion of a window frame as recited in Claim 15. Chen also fails to disclose this feature since the sunshade 1 taught by Chen adheres to the surface of the window such that the sunshade moves with the window as the window is moved down or up. Applicant respectfully submits that the sunshade taught by Chen does not removably attaching the structure to a side window of a vehicle by sliding the structure along an inner surface of a side window of a vehicle, and engaging at least an upper peripheral portion of the structure between the inner surface of the side window and a sealing member portion affixed to an upper frame portion of a window frame as recited in Claim 15. In view of the foregoing, Applicant respectfully submits that independent Claim 15 is patentable over McNelis in view of Murjan or Chen and requests withdrawal of the rejection of Claim 15. Regarding dependent Claims 16-18, Applicant submits that these claims are not obvious in view of the cited references at least for the same reasons given in connection with their base Claim 15.

With regard to Claim 19, Applicant respectfully submits that none of McNelis, Murjan or Chen discloses shaping the structure such that, when the structure is resiliently engaged between an inner surface of a side window of a vehicle and a sealing member of a window frame, a first

peripheral portion of structure engages an upper frame region of the window frame and a second peripheral portion of the structure engages a side frame region of the window frame as recited in Claim 19. As noted above, Murjahn discloses an antiglare shield for exterior mirrors which is designed to minimize headlight glare to a driver from outside rear view mirrors by inserting the lower portion of the antiglare shield between the window and interior wall of the vehicle window shaft. Thus, Murjahn fails to teach shaping the structure such that, when the structure is resiliently engaged between an inner surface of a side window of a vehicle and a sealing member of a window frame, a first peripheral portion of structure engages an upper frame region of the window frame and a second peripheral portion of the structure engages a side frame region of the window frame as recited in Claim 19. Chen also fails to disclose this feature since the sunshade 1 taught by Chen adheres to the surface of the window such that the sunshade moves with the window as the window is moved down or up. Applicant respectfully submits that the sunshade taught by Chen is not shaped such that, when the structure is resiliently engaged between an inner surface of a side window of a vehicle and a sealing member of a window frame, a first peripheral portion of structure engages an upper frame region of the window frame and a second peripheral portion of the structure engages a side frame region of the window frame as recited in Claim 19. In view of the foregoing, Applicant respectfully submits that independent Claim 19 is patentable over McNelis in view of Murjan or Chen and requests withdrawal of the rejection of Claim 19. Regarding dependent Claims 20-25, Applicant submits that these claims are not obvious in view of the cited references at least for the same reasons given in connection with their base Claim 19.

The Examiner has rejected Claims 12-14 under 35 U.S.C. §103(a) as unpatentable over McNelis in view of either Murjan or Chen and further in view of Bittner (U.S. Patent No. 6,394,530). Applicant respectfully traverses this rejection.

As Claims 12-14 are each respectively dependent on independent Claim 10, the discussion above with regard to the independent Claim 10 and the relied upon references applies here. Because the relied upon references do not contain limitations recited in Applicant's independent Claim 10 as set forth above, and because Bittner does not cure these deficiencies, the combination of McNelis, Murjan, Chen and Bittner does not teach or suggest Applicant's dependent claims. Therefore, Claims 12-14 are patentable over McNelis in view of either Murjan or Chen and further in view of Bittner.

The Examiner has further rejected Claims 26 and 29-32 under 35 U.S.C. §103(a) as unpatentable over Idland (U.S. Patent No. 4,749,222) in view of either Murjan or Chen. Applicant respectfully traverses this rejection.

With regard to Claim 26, Applicant respectfully submits that none of Idland, Murjan or Chen discloses a shade structure having an upper peripheral region to engage between an inner surface of a window and a sealing member to seal an upper periphery of the window as recited in Claim 26. As noted above, Murjahn discloses an antiglare shield for exterior mirrors which is designed to minimize headlight glare to a driver from outside rear view mirrors by inserting the lower portion of the antiglare shield between the window and interior wall of the vehicle window shaft. Thus, Murjahn fails to teach a shade structure comprising an upper peripheral region to engage between an inner surface of a window and a sealing member as recited in Claim 26. Chen also fails to disclose this feature since the sunshade 1 taught by Chen adheres to the surface of the window such that the sunshade moves with the window as the window is moved down or up. There is nothing in Chen that teaches that the sunshade 1 shown in figures 1-3 can removably attach to a window by engaging the upper peripheral region and the first side peripheral region of the sunshade between the inner surface of the window and the sealing member. In view of the foregoing, Applicant respectfully submits that independent Claim 26 is patentable over Idland in view of Murjan or Chen and requests withdrawal of the rejection of Claim 26. Regarding dependent Claims 29-32, Applicant submits that these claims are not obvious in view of the cited references at least for the same reasons given in connection with their base Claim 26.

The Examiner has further rejected Claims 26-28 under 35 U.S.C. §103(a) as unpatentable over Bittner in view of Thompson. Applicant respectfully traverses this rejection.

With regard to Claim 26, Applicant respectfully submits that neither Bittner nor Thompson discloses a shade structure having an upper peripheral region to engage between an inner surface of a window and a sealing member to seal an upper periphery of the window, wherein the shade structure to removably attach to the window by engaging the upper peripheral region and the first side peripheral region between the inner surface of the window and the sealing member, as recited in Claim 26. As such, Applicant respectfully submits that

independent Claim 26 is patentable over Bittner in view of Thompson and requests withdrawal of the rejection of Claim 26. Regarding dependent Claims 27 and 28, Applicant submits that these claims are not obvious in view of the cited references at least for the same reasons given in connection with their base Claim 26.

### **CONCLUSION**

In view of the foregoing, it is submitted that the claims are in condition for allowance. Reconsideration of the rejections and objections is requested. Allowance is earnestly solicited at the earliest possible date. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (949) 307-3173.

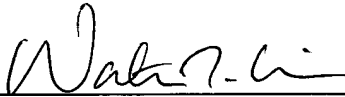
### **PETITION FOR EXTENSION OF TIME**

Applicant respectfully petitions for a one (1) month extension of time, extending the period for response to the Office Action dated September 10, 2004 until January 10, 2005. Attached is a check in the amount of \$60 to cover the petition filing fee for small entity.

If it should be determined that a longer extension of time is required to prevent this application from becoming abandoned, or that more fees are required for the requested amount of time, please contact the undersigned at (949) 307-3173.

Respectfully submitted,

Dated: January 6, 2005



Walter T. Kim,  
Reg. No. 42,731

1885 S. Oswego St.  
Aurora, CO 80012  
(949) 307-3173

#### **CERTIFICATE OF MAILING:**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Amendments, Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 6, 2005.



Walter T. Kim

January 6, 2005